

Application No. 09/265,779  
Applicant: Heinrich GERS-BARLAG et al.  
Amendment Dated June 14, 2004

### **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

New claims 13-16 have been added, which are method claims having the structural limitations of claims 9-12, respectively. Applicants do not believe that the introduction of new claims 13-16 introduces any new matter.

In the middle of page 2 of the final rejection dated July 15, 2003, the Examiner indicated that a reference to the parent application should be inserted as the first sentence of the specification. Such an amendment was already requested on the bottom of page 1 of the Preliminary Amendment dated October 21, 2002. The Examiner apparently received that amendment since it is referenced in the cover page of the final rejection. Accordingly, the requested amendment to the specification should have already been entered. If it has not been entered, then Applicants respectfully request that it be entered now.

Claims 7-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-13 of U.S. Patent No. 5,968,483. In response, Applicants submit a terminal disclaimer relative to the patent.

Application No. 09/265,779  
Applicant: Heinrich GERS-BARLAG et al.  
Amendment Dated June 14, 2004

Claims 7-12 were rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over JP Hei-04/178,316 in view of Applicants' "admissions" on page 2, last paragraph, and page 4, last paragraph. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants previously pointed out that the present claims are encompassed by the claims of U.S. Patent No. 5,968,483, and that the Examiner already considered the instant specification and the JP reference during the prosecution of that application. The Examiner counters that he has changed his mind, and threatens that a reexamination of '483 may be warranted. Such a reexamination presumably would not be at Applicants' initiation inasmuch as the JP reference was considered during the prosecution of the '483 patent and, therefore, its citation in support of a reexamination request could not legally raise a substantially new question of patentability. Applicants submit that the claims are patentable over the cited combination of "references." Therefore, not only is no reexamination of the '483 patent necessary or warranted, but the instant claims are patentable as well.

At best, the Examiner has shown that Applicants' UVB filter and Applicants' emulsifier were both known individually in the prior art, and that both were known in the cosmetic art. That fact is, in and of itself, insufficient to make out a *prima facie* case of obviousness under the present circumstances wherein the present invention solves a problem in the art. The Examiner relies only on those portions of Applicants' specification that are helpful to his case. However, the Examiner overlooks, for example, the last paragraph on page 2 of the instant specification,

Application No. 09/265,779  
Applicant: Heinrich GERS-BARLAG et al.  
Amendment Dated June 14, 2004

wherein it is taught that Applicants' UVB filter suffers from solubility problems; and the third paragraph on page 4 of the instant specification, wherein it is taught that the inclusion of the emulsifiers of the present invention brings about a "stabilization of solutions of [Applicants' UVB filter]," which "not only has a poor solubility but also readily crystallizes out again from its solution."

The fact that both Applicants' UVB filter and Applicants' emulsifier were both known individually in the cosmetic prior art would not have led persons skilled in the art to combine them with a reasonable expectation of success under the circumstances well known here where Applicants' UVB filter was known to suffer solubility and crystallization problems. There is nothing of record to suggest that combining Applicants' UVB filter and Applicants' emulsifier would have solved this problem and have led to an operable formulation characterized by solution stability. The JP reference, while it may generically teach Applicants' emulsifier, is completely silent about the ability of these emulsifiers to stabilize solutions of Applicants' UVB filter. Consequently, a person skilled in the cosmetic art would have had no reason to expect that the combination would have been characterized by stabilized solutions of Applicants' UVB filter.

In view of the foregoing, Applicants submit that the Examiner's original position was quite correct, and that his current position is clearly strained. In order to buttress the Examiner's original position, claim 7 is amended solely for the purpose of emphasizing what should be evident from a fair reading of the entire specification, i.e., that the combination of Applicants' UVB filter and Applicants' emulsifier leads to a novel and unobvious combination.

Application No. 09/265,779  
Applicant: Heinrich GERS-BARLAG et al.  
Amendment Dated June 14, 2004

In short, Applicants believe that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

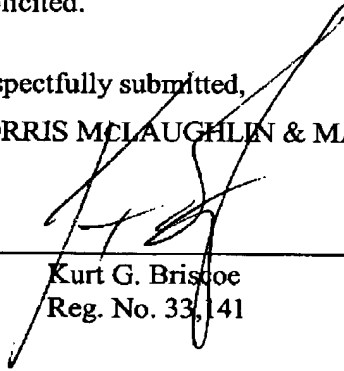
Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,  
NORRIS MCLAUGHLIN & MARCUS, P.A.

By

  
Kurt G. Bristoe  
Reg. No. 33,141

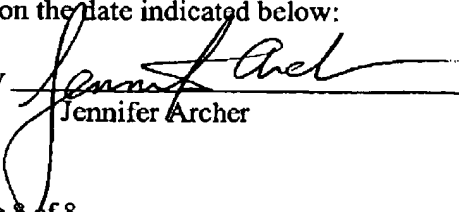
220 East 42<sup>nd</sup> Street - 30<sup>th</sup> Floor  
New York, New York 10017  
Phone: (212) 808-0700

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment (8 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: June 14, 2004

By

  
Jennifer Archer

Page 8 of 8

Application No. 09/265,779  
Applicant: Heinrich GERS-BARLAG et al.  
Amendment Dated June 14, 2004

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.